

REMARKS

I. Amendments

By this amendment, claims 1-7, 9, 12 and 16 have been amended and claims 11 and 17 have been cancelled.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

No change of inventorship is necessitated by this amendment.

II. Consideration of a Previously Submitted Information Disclosure Statement

An Information Disclosure Statement to disclose six references was filed on April 16, 2001. The Examiner has indicated that a copy was not in the file. Accordingly copies of the previously submitted IDS, cited references, transmittal papers and Notice of Acceptance verifying U.S. PTO receipt accompany this response in attached Appendix A.

Applicants respectfully request consideration of the IDS and entry into the record.

III. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph

Claims 1-13 have been rejected under 35 U.S.C. Sec. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Each aspect of the rejection will be discussed separately in the following paragraphs.

In the first aspect of the rejection, the Examiner has objected to the definition of B in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for ring B. This amendment adds no new matter to the specification. Support for the amendment may be found at page 12, line 5 – page 14, line 16 *inter alia*. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the second aspect of the rejection, the Examiner has objected to the definition of R¹ in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for R¹. This amendment adds no new matter to the specification. Support for the

amendment to further define “hydrocarbon group which may have a substituent” may be found at page 20, line 25 – page 31, line 5 and page 12, line 22 – page 14, line 14 *inter alia*; to further define “heterocyclic group which may have substituent(s)” may be found at page 31, lines 6 –10, page 28, line 23 – page 30, line 4 and page 12, line 22 – page 14, line 14 *inter alia*; and to further define “acyl group” may be found at page 31, lines 11-15 and page 26, line 2 – page 27, line 15. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the third aspect of the rejection, the Examiner has objected to the definition of R^2 in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for R^2 . This amendment adds no new matter to the specification. Support for the amendment may be found at page 32, line 7 – page 35, line 2, page 20, line 25 – page 31, line 10 and page 12, line 22 – page 14, line 14 *inter alia*. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the fourth aspect of the rejection, the Examiner has objected to the definition of D in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for D. This amendment adds no new matter to the specification. Support for the amendment may be found at page 19, line 6 – page 20, line 5, page 20, line 25 – page 31, line 5, page 12, line 22 – page 14, line 14 and page 35, lines 19-22 *inter alia*. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the fifth aspect of the rejection, the Examiner has objected to the definition of E in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for E by referring to the preceding definition of R^a in claim 1. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the sixth aspect of the rejection, the Examiner has objected to the definitions of G and L in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for G and L. This amendment adds no new matter to the specification. Support for the amendment may be found at page 20, lines 10-12 and page 36, lines 2-4 *inter alia*. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the seventh aspect of the rejection, the Examiner has objected to the definitions of A, X and Y in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for A, X and Y. This amendment adds no new matter to the specification. Support for the amendment to A may be found at page 12, line 22 – page 14, line 14 *inter alia*;

and to X and Y may be found on page 36, lines 16-18 *inter alia*. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the eighth aspect of the rejection, the Examiner has objected to the definition of the ring formed by R² and an atom on ring B in independent claim 1. By this amendment, Applicants have amended claim 1 to further describe the options for that ring. This amendment adds no new matter to the specification. Support for the amendment may be found at page 14, line 23 – page 16, line 2 and page 12, line 22 – page 14, line 14 *inter alia*. Therefore Applicants assert that this aspect of the rejection has been overcome.

In the ninth aspect of the rejection, the Examiner has rejected to the term “prodrug”. By this amendment, claim 11 has been cancelled, thereby rendering this aspect of the rejection moot.

Claims 2-10, 12 and 13 depend upon claim 1. Modifications corresponding to those made in claim 1 have also been made in the dependent claims. Applicants submit that the more specific dependent claims are also now sufficiently clear, based on the present amendment and explanations given above.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

IV. Discussion of the Rejection of Claim 16 under 35 U.S.C. Sec. 112, First Paragraph

Claim 16 has been rejected under 35 U.S.C. Sec. 112, first paragraph because the specification allegedly lacks enablement for preventing or treating diabetes, obesity, diabetic complications or intractable diarrhea.

By this amendment, claim 16 has been limited to a method of treating diabetes or diabetic complications. Dosage information may be found on page 81, line 26 – page 83, line 7 *inter alia*. Applicants assert that the teaching of the specification that the present compounds are somatostatin receptor agonists is sufficient guidance for those skilled in the art to practice the presently claimed method of treating diabetes or diabetic complications. See for example U.S. Patent No. 6,329,389.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 16.

V. Discussion of the Rejection of Claim 17 under 35 U.S.C. Sec. 112, First Paragraph

Claim 17 has been rejected under 35 U.S.C. Sec. 112, first paragraph for allegedly failing to comply with the enablement requirement.

By this amendment, claim 17 has been cancelled, rendering the rejection moot.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim.17.

VI. Conclusion

Reconsideration of the claims and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

Dated: June 7, 2005

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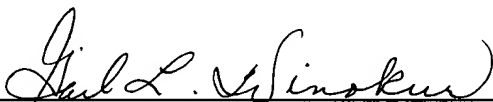
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